

## **REMARKS**

### **I. INTRODUCTION**

The Non-Final Office Action mailed September 25, 2008 (hereinafter "the Office Action"), has been carefully considered. In light of the present amendment and the following discussion, favorable reconsideration of this application is respectfully requested.

### **II. STATUS OF THE CLAIMS**

Claims 1-16 are pending with Claim 1 being independent. By the present amendment, Claim 5 is amended to recite "Polytetraflouroethylene" in lieu of "Teflon." Applicant respectfully submits that it was known at the time of filing the application that Polytetraflouride is the generic name for Teflon and, therefore, no new matter is added by the amendment to Claim 5.

### **III. SUMMARY OF THE OFFICE ACTION**

In the Office Action, the Examiner rejects Claim 5 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention; rejects Claims 1 and 3-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,354,851 to *Hix et al.* (hereinafter "*Hix*") in view of U.S. Patent No. 3,565,039 to *Remer* (hereinafter "*Remer*") as supported with U.S. Patent No. 4,293,954 to *Echtler* (hereinafter "*Echtler*"); and rejects Claim 2 under 35 U.S.C. § 103(a) as unpatentable over *Hix* in view of *Remer* as supported by *Echtler* and in further view of U.S. Patent Application Publication No. 2002/0104761 to *Briss et al.* (hereinafter "*Briss*"). The Examiner also provisionally rejects Claims 1-4, 9, 13, and 16 on the ground of nonstatutory obviousness-type double patenting as unpatentable over Claims 13 and 17-20 of co-pending U.S. Patent Application Serial No. 11/792,978.

#### IV. SPECIFICATION

The specification is amended to correct minor informalities. More specifically, paragraph [0021] is amended to add the phrase “method of the present invention” to correct a typographical error, and is amended to add the generic name for Teflon – Polytetrafluoride – to place the specification in accord with MPEP § 608.01(v). Applicant respectfully submits that it was known at the time of filing the application that Polytetrafluoride is the generic name for Teflon and, therefore, no new matter is added by the amendment to paragraph [0021].

#### V. CLAIM REJECTIONS

##### A. Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects Claim 5 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. More specifically, the Office Action rejects Claim 5 for reciting the trademark/trade name “Teflon.” By the present Amendment, Claim 5 is amended to recite “Polytetrafluoroethylene” in lieu of “Teflon.” Polytetrafluoroethylene is the generic substance that can be purchased under the trademark/trade name Teflon. Thus, Claim 5 positively recites a substance rather than a name used to identify its source. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 5 under 35 U.S.C. § 112, second paragraph.

##### B. Rejection of Claims 1 and 3-16 Under 35 U.S.C. § 103(a)

The Office Action rejects Claims 1 and 3-16 under 35 U.S.C. § 103(a) as unpatentable over *Hix* in view of *Remer* as supported with *Echtler*. In making that rejection, the Examiner acknowledges that *Hix* is “silent [about] applying heat by dipping the article to be decorated *and the transfer sheet* into a bath of non-ferrous metal alloy.” Office Action at 3 (emphasis added).

To address that deficiency, the Examiner asserts that *Remer* teaches a “hot metal dip drying technique with the advantage of not only drying the webs to effect solvent *removal*, but also *removing* any electrical charges from the webs.” *Id.* (emphasis added). Not only does *Remer* relate to heating an article to “remove” substances therefrom instead of transferring a substance thereto, it also fails to disclose or suggest dipping the article “and the transfer sheet” as an assembly, as recited in independent Claim 1. In addition, *Echtler* is cited merely for the composition of the wood’s alloy described therein. Accordingly, neither *Remer* nor *Echtler* cure the acknowledged deficiencies of *Hix*.

In more detail, *Hix* describes two different configurations for a heat transfer press 10 and 30. One heat transfer press 10 is describe as including “a pressure line used to provide the pressure exerted by the movable member (13) in compressing the printed sheet (19) against the rigid panel (20)” (column 5, 41-44). And, the other heat transfer press 30 is described in terms of “the rigid panel (40) and printing paper (41) [being] compressed as they pass between the rollers (34) and (36) by a pressure up to about 50 psi” (column 6, lines 15-20). Thus, unlike the claimed invention, the pressures applied by the movable member 13 and rollers 34 and 36 make each “press” 10 and 30 described in *Remer* unsuitable for transferring a heat-activated substance to an article that is fragile or has a complex shape.

The claimed invention is suitable for transferring a heat-activated substance to an article that is fragile or has a complex shape by forming an assembly of the article to be decorated and a transfer sheet printed with at least one heat-activated substance and quenching that assembly in a non-ferrous metal alloy bath. By contrast, the printing and coating apparatus described in *Remer* is described as transferring a coating to an article by either applying the coating with an aerosol spray nozzle 60 (column 6, lines 71-72) or running the article between two rollers 24 and

26 (column 3, lines 43-47) or 62 and 63 (column 7, lines 30-38). None of those configurations disclose or suggest transferring the coating by quenching the article in a non-ferrous metal alloy bath. Instead, the web 30 of *Remer* is dipped into a metal bath 88 only “after receiving a deposit of a coating formulation” (column 10, lines 48-51). Accordingly, the coating is transferred to the web 30 prior to the web 30 being dipped in the metal bath 88 rather than “by quenching the assembly in a non-ferrous metal alloy bath,” as recited in independent Claim 1. Moreover, *Remer* only describes dipping the web 30 in the metal bath 80, not an assembly formed by applying a transfer sheet to the article to be decorated, as also recited independent Claim 1.

By way of further distinction, the metal bath 88 described in *Remer* is used to remove a substance *from* the web 30 rather than transferring a substance *to* the web 30. More specifically, the coating transferred to the web 30 prior to the web 30 being dipped in the metal bath 88 is described as including an ink or coating composition that is dispersed or dissolved in a solvent (See, e.g., column 1, lines 8-10); column 7, lines 36-38). And, as the Examiner acknowledges, the metal bath provides the advantage of “drying the webs to effect solvent removal.” Office Action at 3-4. Thus, the metal bath 88 of *Remer* removes a substance (i.e., solvent) *from* the web 30 rather than transferring a substance *to* the web 30.

Because neither *Hix* nor *Remer*, either alone or in combination, disclose or suggest applying heat by dipping the article to be decorated *and the transfer sheet* into a bath of non-ferrous metal alloy, and *Hix* only describes *removing* a substance with a metal bath, *Remer* fails to cure the deficiencies of *Hix*. And, because *Echtler* is cited merely for the composition of the wood’s alloy described therein, it fails to cure the deficiencies of both *Hix* and *Remer*, alone and in combination. Accordingly, the Office Action has failed to provide a *prima facie* case of

obviousness for Claims 1 and 3-16, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims under 35 U.S.C. § 103(a).

**C. Rejection of Claim 2 Under 35 U.S.C. § 103(a)**

The Office Action rejects Claim 2 under 35 U.S.C. § 103(a) as unpatentable over *Hix* in view *Remer* as supported by *Echtler* and in further view of *Briss*. Claim 2 depends from independent Claim 1. And, as discussed above, none of *Hix*, *Remer*, and *Echtler*, either alone or in combination, disclose or suggest all of the features of independent Claim 1. *Briss* is cited merely for describing the composition of a metal bath. Accordingly, *Briss* does not cure the deficiencies of *Hix*, *Remer*, and *Echtler*, either alone or in combination, and the Office Action has failed to provide a *prima facie* case of obviousness for Claim 2 for at least the reasons set forth with respect to independent Claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 2 under 35 U.S.C. § 103(a).

**VI. CONCLUSION**

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

In the event there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may further be expedited.

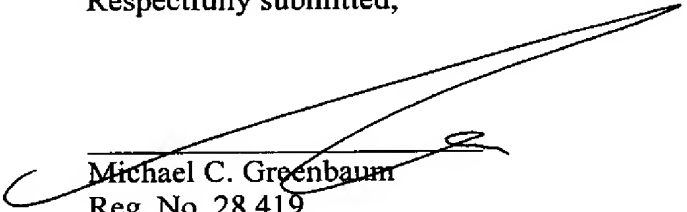
Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (124545-00102). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of

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time for as many months as are required to render this submission timely. Any fees due are authorized above.

Respectfully submitted,

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